

Remarks and Interview SummaryI. HISTORY

This application was filed May 13, 1987, copying claims from Williamson Reexamination Certificate B1 4,369,563, with a preliminary amendment correcting the specification and inserting the copied claims. The PTO has issued only one Office Action in this application, namely Paper No. 5 on July 17, 1989, to which applicant responded on August 14, 1989. Applicant filed supplemental amendments on 8/19/91 (amending the related applications section), 6/14/93 (transferring claims from a companion case), 12/13/95 (correcting the specification and amending certain transferred claims), 4/15/96 (amending certain transferred claims and adding one dependent claim), 8/6/96 (canceling all non-interfering claims), and 8/22/96 (correcting a minor error to interference claim 13).

The Office sent a Letter on May 15, 1996, to which no response was required. A protest was filed in January 28, 1997. An interference was declared on July 20, 1998 (Paper No. 34). Judgment for Lemelson in the interference was entered on April 27, 1999. The protest was filed by the interference opponent and essentially requested that prosecution be suspended and the application included in a copending interference. It should now be denied as moot.

A section of the 1987 preliminary amendment was entitled "support for copied claims" and contains a number of errors in analysis. Assignee respectfully requests that the Examiner completely disregard that analysis in examining this case.

II. CLAIMS PENDING

As a result of the above-discussed papers, claims 11-28 remain pending. A typo is being corrected in claim 26 (misspelled "sation" instead of "station"). Claims 29-79 were formerly in this application. Claims 80-84 are being added now, which correspond to claims 17, 19, 20, 21, and 23, except with "means-plus-function" language converted to generic elements, "machine tool" changed to "tool," and certain other clarifying changes.

III. INTERVIEW SUMMARY.

The undersigned and SPE Banks met on July 27, 2005, to discuss this application. Principally, the parties discussed the various Williamson Preliminary Motions filed in the interference by the Patent Defense Group, and the undersigned asked the Examiner to review those papers, as they contain a variety of arguments for non-patentability of the pending claims to Lemelson or denial of priority under Section 120 to the 4/10/67 application awarded for purposes of the interference. Assignee's attorney thanks the Examiner for his attention during the interview.

The following discussion briefly summarizes the preliminary motions (corresponding to motion numbers) and outlines the principal responsive arguments:

1. Double Patenting: Mainly, the Group relied on claim 13 of the '889 Patent, although it used other supporting claims from the '889 Patent and the '014 Patent and its reissue. One main distinction is that the prior claims lack the feature of selective accessibility of workpieces from storage.

In addition, the claims appear distinct from other parent patents and from the claims issued last year. Some of the claims issued in the patent last year were once part of this application, but they had been determined to be distinct from the interference subject matter. SPE Banks has apparently allowed the companion method interference, and these apparatus claims are distinct from that application too.

2. Inequitable Conduct: The undersigned investigated the trumped-up charges in the Group's motions and found no indication of any attempt to do anything inequitable. Assignee encourages the Examiner to review the motion to ensure that he is not laboring under any misimpressions caused by any previous statements.

3. Prosecution History Laches: Applicant copied the claims within one year from the date of the reexamination certificate, which complies with the statutory bar for presenting claims in 35 U.S.C. §135(b). The Office's delay in proceeding with examination of this application is, frankly, epic, and a laches issue under *Bogese* would be wholly

unwarranted. Assignee has previously provided explanation of the conflict of interest arising from his prior attorney representing both Lemelson and Williamson simultaneously, which explains at least in part why the claims were not presented in the Lemelson application but instead placed in the Williamson application. If further information is required, it can be provided. It is hard to imagine how Lemelson could have copied claims before they issued, particularly in the circumstances present here.

4. Wagenseil-Hughes: Examiner Howell's 5/15/96 letter (which Examiner Banks has confirmed) explains that the claims distinguish over this reference, properly interpreted, because of its lockstep motion of workpieces from one tool to the next. Again, accordingly, one main distinction is that the Wagenseil-Hughes art lacks the feature of selective accessibility of workpieces from storage.

5. IBM-Serafin: This Examiner has carefully examined the IBM question in the course of examining the patent that issued last year and the copending method interference application. Again, one main distinction is that the IBM art lacks the feature of selective accessibility of workpieces from storage.

6. Pre-1953 Art: This refers to older references, which refer to automated factories with lockstep movement between tools. Again, one main distinction is that the art lacks the feature of selective accessibility of workpieces from storage.

7. Williamson publications: This argument depends on denying Lemelson priority earlier than his 1971 application (see 11-14 below).

8. Allen Interference: This argument asserts that the lost counts of the Allen-Lemelson interference are prior art and bar issuance of the claims for interference estoppel reasons. The lost counts are directed to different patentable inventions, however. The Examiner has previously addressed this question.

9. Fair Interference: This argument asserts that Lemelson should have copied the claims from the Fair patent within one year from their issuance, and that Lemelson is bound because his then assignee of a parent application, Molins, chose to participate in

an interference with Fair using the Williamson application instead of the Lemelson application. Again, the Fair claims are directed to different patentable inventions, however. The Examiner has previously addressed a similar question.

10, 15. Written Description: The Group asserted that three aspects, in only certain of the pending claims, are not found in Lemelson's current specification or intermediate continuation parent applications. This subject was discussed at length in the interview. This issue is unique to this application and has not been addressed before, to assignee's knowledge. Briefly:

(a) As to the challenge re: "process indicia," Lemelson's specification discloses codes on the pallet that can be used to direct the pallet or control tools. The specification, as originally filed in 1987, discloses this feature, for example, on page 38, paragraph I (last three lines); page 39, paragraph III (last sentence); and page 39, paragraph IV (beginning on the sixth line).

(b) As to the challenge re: "means responsive to conveyance," this might be the same codes, or various other alternatives disclosed in the specification.

(c) As to the challenge re: "transfer stations" in claims 16, 17, and 26, assignee refers the Examiner to the beginning (and end) of the conveyor (e.g., Lemelson Fig. 6). Serafin (IBM) describes entry points as a "dispatch station," so it is known in the art to call part of a conveyor a "station." Indeed, the Williamson patent, from which these claims were copied, use a transporter (but not a conveyor belt), which is loaded and unloaded at the transfer stations, and the transporter moves from one end of the path to the other. See Williamson Figs. 1, 2. Assignee notes that claims 17 and 26 say that the transfer station addresses motion "to and from said machine tool installation," which the Examiner questioned in the interview. However, the claim language also says that the transferring means may include such transfer at "at least one transfer station." Accordingly, there is no

requirement that there be only one transfer station, and Lemelson's linear conveyor can be viewed as having a transfer station at each end for those claims.

11-14. Priority under Section 120: These motions contained various arguments seeking to deny Lemelson priority to the 1967 or earlier applications of the so-called "(a)-series." This subject has been addressed thoroughly in previous applications, and the Examiner and the Office have granted priority despite such arguments. The Petitions Office's decision supports the Examiner's conclusions in this regard. If a replacement oath is required, please advise. As he did during the copending method interference application, the Examiner should confirm that Lemelson's 1967 specification disclosed the same or equivalent means, where there are "means plus function" elements, as part of his priority review.

16. Williamson Foreign Applications: The Group sought priority to certain U.K. applications, including two predating Lemelson's 4/10/67 application filing date. Under the *Hilmer* doctrine, even if granting priority would have been proper, the U.K. priority applications are not prior art to Lemelson's application. Williamson does not have priority under Section 102(g) either, because there is no evidence of any invention in this country before Lemelson's effective date. This subject was addressed at length during the examination of the copending method interference application, which we understand the Examiner has allowed.

17. Section 135(b): The Group argued that Lemelson should have copied the claims within one year of issuance of the Williamson '563 Patent, rather than waiting for the reexamination certificate to issue later and that the claims are accordingly barred under Section 135(b)'s one-year time limit. The motion argues that the copied reexamination claims are directed to the same patentable invention as at least some of the original patent's claims. This issue is unique to this application and has not been addressed before, to assignee's knowledge. Assignee submits to the contrary that the reexamination claims copied were directed to a different patentable invention from any of the original

patent's claims. One main distinction is that the claims of the Williamson '563 Patent lack the feature of selective accessibility of workpieces from storage. This distinction appears of patentable importance, as reflected in the file history of the Williamson reexamination, because the Office rejected some of the originally issued '563 Patent claims over the IBM references, which Williamson overcame by amending the claims to add the feature of selective accessibility, thus distinguishing IBM.

18. Williamson claims: For completeness, Williamson's last motion sought to add two Williamson claims to the interference, which has no bearing on patentability of Lemelson's claims.

Assignee respectfully submits that this application stands in condition for allowance and requests prompt action. The Examiner has completed most of the work during his previous examinations of the two related application that he has allowed.

Assignee's undersigned attorney remains available by telephone at any time to answer any questions regarding this matter or to expedite handling.

Respectfully submitted,

LEMELSON MEDICAL, EDUCATION &
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by its attorney



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